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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/748,017	12/29/2003	Sanjoy Ganguly	C-608	6508

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Sun Chemical Corporation
222 Bridge Plaza South
Fort Lee, NJ 07024

EXAMINER

SAMALA, JAGADISHWAR RAO

ART UNIT	PAPER NUMBER
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1618

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
31 DAYS	03/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/748,017

Applicant(s)

GANGULY ET AL.

Examiner

Jagadishwar R. Samala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 33-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

-Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/29/2004 & 05/20/2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election Acknowledged

1. Applicant's election of group I to the Restriction Requirement was acknowledged on March 12, 2007.

Claims Disposition

2. Claims 1-38 are pending and elected claims 1-32 are pending and presented to examination. Claims 33-38 are withdrawn for consideration and will be rejoined if the group I is found to be an allowable subject matter.

Information Disclosure Statement

3. The Information Disclosure Statement (IDS) filed on March 29, 2004 and May 20, 2005 has been received and entered. The references cited on the PTO-1449 Form have been considered by the examiner and a copy is attached to the instant Office Action.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-32 are, drawn to a cosmetic composition comprising a nacreous pigment having a coated synthetic mica, classified in class 424, subclass 489.

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- II. Claims 33-38 are, drawn to a method for increasing gloss, whiteness, compressibility, transparency, brightness and glint of a cosmetic composition, classified in class 514, subclass 938

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case group II the process for using the product can be practiced with materially different product.

3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

Applicant is advised that a reply to this requirement to be complete must include (i) an election of invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

4. During a telephone conversation with Sidney Persley on March 12, 2007 a provisional election was made without traverse to prosecute the invention of group I, claim1-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 33-38 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claims 1-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation of "a nacreous pigment having a coated synthetic mica" is indefinite. The meets and bound of this recitation are not clear, since this would encompass a nacreous pigment coated with synthetic mica or synthetic mica is coated with nacreous pigment. Since this definition provides no clear structure, but only is defined by property (i.e. comprising a nacreous pigment having a coated synthetic mica), the scope of this recitation cannot be ascertained. A material defined solely in terms of a property does not particularly point out. See *Ex parte pulvari* (POBA 1966) 157 USPQd 169.

Claims 4-6 and 9-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "gloss of at least" 40%, 60% and 80% in claims 4-6 and "whiteness of at least" 70% and 80% are relative term which renders the claims indefinite. The term "gloss of at least and whiteness of at least" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-21 and 23, 24 and 26-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Fu (US 6,056,815)

Fu discloses a cosmetic composition comprising natural or synthetic mica such as muscovite, phlogopite, and biotite coated with nacreous pigment titanium dioxide having particle size of 5-400 microns (see column 2, lines 41-65+ and claim 12). Fu also discloses a promising area of application for cosmetic products in areas such as cosmetics, food stuffs and food contact applications and thereof (see column 4, lines 46-50).

Since the essential elements of the Fu cosmetic composition are identical to the instant composition (i.e. nacreous pigment, synthetic mica and particle size), the composition would inherently have the same physiochemical properties such as gloss, whiteness, compressibility, transparency, and brightness as the composition set forth in the instant application. (All these properties are inherent and vary with the composition of nacreous pigment e.g. see Defossez et al. US 5,486,354; Kimura et al. US 4,623,396). Thus the claims are readily envisaged by the teaching of the cited reference and the claims are properly included in the rejection.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 4-8, 23, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Calello et al (US 6,033,650).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the coated synthetic mica has a gloss of at least 40-80% therein. However a cosmetic composition with gloss and shine having improved transfer resistance is well known in the art as shown by Calello.

Calello discloses a cosmetic composition, particularly a lipstick, with long lasting adherence to skin and which also has gloss and shine (see column 2, lines 3-5).

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It would have been obvious to one of ordinary skill in the art to modify the composition comprising natural or synthetic mica substrate coating with nacreous pigments, disclosed by Fu to formulate a composition which yields a film which exhibits high gloss high shine cosmetics because Calello teaches that the incorporation of ingredients to improve gloss as three out of every five women prefer lipsticks which are glossy because they provide a dewy look which is associated with youthfulness and good health.

Because the cosmetic compositions with high gloss high shine have excellent long lasting adherence to the skin, or superior transfer resistance, one of ordinary skill in the art would have been motivated to incorporate active ingredients in the composition advanced by Fu. Based on the teaching of Calello, there is reasonable expectation that the cosmetic composition with high gloss, which yields a film, which exhibits, reduced permeability to oil and water would be highly desirable compositions in cosmetic industry. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of pigmented cosmetic compositions such as makeup, blush, lipstick and eye shadow, are used to color the skin and lips and at the same time provide high gloss of composition advanced by Fu in view of the composition taught by Calello.

11. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Sandewicz et al (US 6,451,329 B1).

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Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the coated synthetic mica having an increased whiteness of at least 5-10% therein. However a cosmetic composition with excellent whiteness, color tone (e.g. opacity) is well known in the art as shown by Sandewicz.

Sandewicz discloses a cosmetic composition comprising a titanium-mica composite material having an extremely improved color tone and good consistency of the appearance of color (see column 2, lines 45-50).

It would have been obvious to one of ordinary skill in the art to modify the composition disclosed by Fu to provide an improved color tone and various interference colors and whiteness because Sandewicz teaches that cosmetic composition containing one or more inorganic or organic particulates or colorants may provide color, whiteness, opacity, for reducing the shiny appearance of skin and cosmetically improving the appearance of skin imperfections.

The cosmetic composition which provide color, whiteness, opacity, are capable of reducing the undesirable shiny appearance of skin having excessive oil on its surface, one of ordinary skill in the art would have been motivated to incorporate color pigment in the composition advanced by Fu. Based on the teaching of Sandewicz, there is reasonable expectation that the composition with whiteness, opacity, and activity yields a film, which improves the appearance of skin imperfections such as fine lines,

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wrinkles, and blemishes. At the same time these composition do not provide the heavy made-up look that is often seen in compositions containing oil-blotting absorbent powders. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of pigmented cosmetic compositions such as makeup, to improve the appearance of skin imperfections, and at the same time provide whiteness of composition advanced by Fu in view of the composition taught by Sandewicz.

12. Claims 1,21,22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fu (US 6,056,815) in view of Miyoshi et al. (US 5,968,531).

Fu discloses a composition comprising natural or synthetic mica substrate coating with nacreous pigments, such as titanium dioxide which results in stronger luster and color effects, and its higher stability in indoor weathering (see abstract).

Fu fails to disclose composition wherein the synthetic mica is fluorphlogopite. However a cosmetic composition relating to compressed powder cosmetics effective in protecting the skin against ultraviolet rays is well known in the art as shown by Miyoshi.

Miyoshi discloses a composite powder based on substrate particles such as synthetic fluorphlogopite mica coated with micronized metal oxides particles (see column 3, lines 12-15).

It would have been obvious to one of ordinary skill in the art to modify the composition disclosed by Fu to include synthetic fluorphlogopite mica as substrate particle because Miyoshi teaches that the incorporation of synthetic fluorphlogopite mica

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coated with micronized metal oxides particles such as titanium dioxide provides a cosmetic composition effective in protecting the skin against ultraviolet rays.

Because the cosmetic composition having ability to protect the skin against ultraviolet rays and have excellent long lasting adherence to the skin, one of ordinary skill in the art would have been motivated to incorporate synthetic fluorophlogopite mica coated with micronized metal oxides particles in the composition advanced by Fu. Based on the teaching of Miyoshi, there is reasonable expectation that the cosmetic composition having excellent long lasting adherence to skin and protect from ultraviolet rays would be highly desirable composition in cosmetic field. As such, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make use of synthetic fluorophlogopite mica coated with micronized metal oxides composition which has a smooth, lubricious and pleasant feel on the skin and retains its transparency advanced by Fu in view of the composition advanced by Miyoshi.

Conclusion

1. No claims are allowed at this time.
2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagadishwar R. Samala whose telephone number is (571)272-9927. The examiner can normally be reached on 8.30 A.M to 5.00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571)272-0616. The fax phone

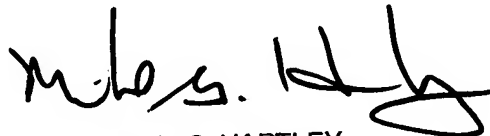
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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jagadishwar R Samala
Examiner
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sjr

A handwritten signature in black ink, appearing to read "Michael G. Hartley", with a stylized flourish at the end.

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER